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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK A. FELKEY, TYLER J. WEST, SUSAN O. DIEMER,
MICHAEL E. MARCELLIN, DIANE L. SABATINI, ELAINE S. MASON,
DAVID K. BRAVERMAN, and PATRICIA A. BOYER

Appeal 2009-005992
Application 10/051,180¹
Technology Center 2400

Before JAMES D. THOMAS, HOWARD B. BLANKENSHIP, and JAY P.
LUCAS, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

DECISION ON APPEAL²

¹ Application filed January 22, 2002. Appellants claim the benefit under 35 U.S.C. § 119 of U.S. provisional patent application 60/263,222 filed January 23, 2001. The real party in interest is MCI Inc.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants appeal from a final rejection of claims 1 to 40 under authority of 35 U.S.C. § 134(a). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

We affirm the rejection.

Appellants' invention relates to a method of selling telecommunications services online (Spec. ¶ [07]). In the words of Appellants:

[A] logical architecture [is] employed in [a] system for providing software integration for a telecommunications services on-line procurement system In Figure 5, the logical architecture includes a web tier, an application tier, a database tier and a service availability tool.

(Spec. ¶ [44]).

The web tier is responsible for delivering web content (e.g., HyperText Markup Language (HTML) pages, static content, images, Javascript scripts and cascading style sheets, etc[.]) to the client machines.

(Spec. ¶ [45]).

The application tier includes [a] presentation tier framework Functionality from the presentation tier framework ... is leveraged to build a customer portal. This is achieved by reusing and/or configuring the existing JavaServer Pages (JSPs) and objects including transition and display policies of the presentation tier framework.

(Spec. ¶ [48]).

The following claim illustrates the claims on appeal:

Claim 1:

1. A system for providing software integration for on-line procurement of telecommunications offerings, comprising:

a web tier configured to receive a request or a user action from a web server; and

an application tier coupled to the web tier and configured to perform order management, online ordering or user management functions,

wherein the web tier or the application tier includes software objects extended from general-purpose software objects to support procurement of the telecommunications offerings on-line and custom software objects created to support procuring of the telecommunications offerings on-line.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Crawford	US 6,014,651	Jan. 11, 2000
Elsbree	US 6,834,388 B1	Dec. 21, 2004
		(filed Mar. 12, 1999)

REJECTION

The Examiner rejects the claims as follows:

Claims 1 to 40 stand rejected under 35 U.S.C. § 103(a) for being obvious over Crawford in view of Elsbree.

We have only considered those arguments that Appellants actually raised in the Briefs. Arguments Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

The issues involve whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The first issue specifically turns on whether Crawford and Elsbree render obvious Appellants' claimed "web tier," "application tier," and "software objects extended from general-purpose software objects" (claim 1). The second issue is whether the Examiner properly combined the references.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

Disclosure

1. Appellants have invented a system and method for buying services online. (*See* claim 1.) Appellants' claimed system includes a web tier and an application tier (*id.*). Either the web tier or the application tier includes customizable software objects (*id.*).

Crawford

2. The Crawford reference discloses a system for buying services online. (*See* Abstract; col. 2, ll. 14 to 23; col. 15, ll. 31 to 36.) The system may include two tiers. (*See* col. 3, ll. 22 to 30.) A first tier may be visible to a

customer purchasing online services (col. 3, ll. 22 to 25). A second tier may operate in the background, calling on a database to fulfill a user's request (*id.* at 26 to 30).

Elsbree

3. The Elsbree reference discloses customizable software objects. (*See* col. 6, ll. 19 to 21 and 35 to 39.)

PRINCIPLE OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

ANALYSIS

*Arguments with respect to the rejection
of claims 1 to 40
under 35 U.S.C. § 103(a)*

The Examiner has rejected the noted claims as being obvious over the combination of Crawford and Elsbree, pages 3 to 10 of the Examiner's Answer.

Appellants argue the Examiner improperly equates Crawford's access to a virtual disk drive with the claim limitation "application tier coupled to the web tier" or any type of "on-line procurement of telecommunications offerings," as claim 1 requires (App. Br. 11, top).

We disagree with Appellants' argument for the following reasons. We find that Appellants have invented a system and method for buying

services online (FF#1). Appellants' claimed system includes a web tier and an application tier (*id.*). Either the web tier or the application tier includes software objects that are customizable (*id.*). In comparison, the Crawford reference discloses a system for buying services online (FF#2). Crawford generally discloses a system that may include two tiers (*id.*). In Crawford, a first tier (Appellants' claimed "web tier") may be visible to a customer purchasing online services (*id.*). The reference discloses a second tier (Appellants' claimed "application tier") that may function in the background, calling on a database to fulfill a user's request (*id.*). In addition, the Elsbree reference discloses customizable software objects (FF#3).

Our reviewing court has held that nonfunctional descriptive material cannot lend patentability to an invention that would have otherwise been anticipated by the prior art. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

In accordance with the teachings of *In re Ngai* (cited above), we read Appellants' argued claim phrase "telecommunications offerings" (claim 1) as being nonfunctional descriptive material. That is, the "telecommunications offerings" bear no functional relationship to the limitations of claim 1. Thus, the mere fact that Crawford provides for procurement of any type of services in an online environment suffices to meet the claimed "system for providing software integration for on-line procurement," as recited in the preamble of claim 1. We further note that

Crawford's online services (the claimed "web tier"), which are visible and accessible to customers, are indeed "coupled," as claimed, to a backend database (the claimed "application tier") (FF#2). We find that Crawford's system operates no differently from Appellants' claimed "application tier coupled to the web tier." Accordingly, Appellants have not shown error in the Examiner's conclusion of obviousness in this regard.

Next, Appellants contend that Elsbee's instance object cannot be equated with "software objects extended from general-purpose software objects," as claimed (App. Br. 12, middle).

We do not agree with Appellants. We note that Elsbee is merely cited by the Examiner for disclosing widely known software programming methodologies. (See FF#3.) More particularly, the Examiner has pointed to "real-time interactive control and communication software objects" that "have interactive capabilities." (Col. 6, ll. 14 to 19). We find that Elsbee's above-stated disclosure reads on the claim limitation "software objects extended from general-purpose software objects" of claim 1. Accordingly, we find that Appellants have not shown error in the Examiner's analysis.

"[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *Kahn*, 441 F.3d at 988).

The Examiner finds that Elsbee's customizable software objects would "improve the functionality of Crawford's system by allowing the objects to carry additional information for product collection and distribution." (Ans. 5, top).

Appellants dispute the rationale for combining the Crawford and Elsbree references (App. Br 14, middle). Appellants argue that the rationale is incorrect because there is no need established by any portion of Crawford for reuse of existing codes or for dynamically creating objects in a quicker and more efficient manner (*id.*).

The Supreme Court's ruling in *KSR* extinguished the notion that the teaching-suggestion-motivation (TSM) test was the only means for determining obviousness. The Examiner's proffered rationale for forming the combination of references need not come from the disclosures themselves. Instead, the Examiner has applied common sense in fitting the teachings of the Crawford and Elsbree together like puzzle pieces. (*KSR* at 402) (holding that "[i]t is common sense that familiar items may have obvious uses beyond their primary purposes, and a person of ordinary skill often will be able to fit the teachings of multiple patents together like pieces of a puzzle.") That a person of ordinary skill in the art would consider Elsbree for its disclosure of standardized software programming techniques would not have been beyond the grasp of the skilled artisan, as such an artisan is accorded more than the capabilities of a mere automaton. (*KSR* at 421)(holding that "[a] person of ordinary skill in the art is also a person of ordinary creativity, not an automaton.") Accordingly, we find that Appellants have not shown error in the combination of the references.

In accordance with 37 C.F.R. § 41.37(c)(1)(vii), Appellants separately argue claims 2 to 5 (App. Br. 15 to 18). Appellants argue that the Examiner failed to make a showing for the claimed "reconfigured software objects that include reconfigured JavaServerPages (JSPs), reconfigured transition policies, or reconfigured display objects" of claims 2 and 4 (App. Br. 15 to

16). Appellants further argue that the Examiner failed to make findings for the claimed “custom software objects that include custom JavaServerPages (JSPs), custom transition policies, or custom display objects,” as required by claims 3 and 5 (*id.* at 17 to 18).

We adopt and endorse the Examiner’s findings with respect to the separately argued dependent claims. We refer Appellants to the “Response to Arguments” section of the Examiner’s Answer for further details (Ans. 14 to 15).

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have not shown the Examiner erred in rejecting claims 1 to 40.

DECISION

We affirm the Examiner’s rejection of claims 1 to 40.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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